

Grant E. Kinsel (State Bar No. 172407)
E-Mail: gkinsel@foley.com
FOLEY & LARDNER LLP
555 South Flower Street, Suite 3500
Los Angeles, CA 90071-2411
Telephone: 213.972.4500
Facsimile: 213.486.0065

Michael J. Song (State Bar No. 243675)
E-Mail: msong@foley.com
FOLEY & LARDNER LLP
975 Page Mill Road
Palo Alto, CA 94304-1125
Telephone: (650) 856-3700
Facsimile: (650) 856-3710

Attorneys for Plaintiff
ABBYY USA SOFTWARE HOUSE, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ABBYY USA SOFTWARE HOUSE, INC.

Plaintiff,

vs.

NUANCE COMMUNICATIONS, INC.

Defendant.

Case No: CV 08-1035 JSW

**ABBYY USA SOFTWARE HOUSE, INC.'S
ANSWER TO COUNTERCLAIMS OF
NUANCE COMMUNICATIONS, INC.;
DEMAND FOR JURY TRIAL**

1 Answering for itself and no other party, Abbyy USA Software House, Inc. (“Abbyy
2 USA”) answers the Counterclaims of Nuance Communications, Inc. (“Nuance”) as follows:

3 **NATURE OF THE LAWSUIT**

4 1. Abbyy USA admits that the Counterclaims purport to allege an action for patent
5 infringement, trade dress infringement and unfair competition, but denies that there is any basis
6 for such an action. Abbyy USA will respond to the jurisdictional and venue allegations below.

7 **THE PARTIES**

8 2. Abbyy USA is without information sufficient to form a belief as to the truth of the
9 allegations contained in paragraph 33, and on that basis, denies the allegations.

10 3. Abbyy USA admits that it is a California corporation with a principal place of
11 business in Fremont, California.

12 **JURISDICTION AND VENUE**

13 4. Abbyy USA admits that the Counterclaims purports to allege an action for patent
14 infringement over which this Court has subject matter jurisdiction. Abbyy USA further admits
15 that venue is proper in this Court.

16 **NUANCE’S PATENTS**

17 5. Abbyy USA admits that U.S. Patent No. 5,131,053 (“the ‘053 patent”) indicates
18 on its face that it was issued on July 14, 1992. Abbyy USA is without information sufficient to
19 form a belief as to the truth of the allegations regarding ownership contained in paragraph 36,
20 and on that basis, denies the allegations. Abbyy USA denies that the ‘053 patent was properly
21 issued and that it is valid.

22 6. Abbyy USA admits that U.S. Patent No. 5,381,489 (“the ‘489 patent”) indicates
23 on its face that it was issued on January 10, 1995. Abbyy USA is without information sufficient
24 to form a belief as to the truth of the allegations regarding ownership contained in paragraph 37,
25 and on that basis, denies the allegations. Abbyy USA denies that the ‘489 patent was properly
26 issued and that it is valid.

27 7. Abbyy USA admits that U.S. Patent No. 5,436,983 (“the ‘983 patent”) indicates
28 on its face that it was issued on July 25, 1995. Abbyy USA is without information sufficient to

1 form a belief as to the truth of the allegations regarding ownership contained in paragraph 38,
2 and on that basis, denies the allegations. Abbyy USA denies that the '983 patent was properly
3 issued and that it is valid.

4 8. Abbyy USA admits that U.S. Patent No. 6,038,342 ("the '342 patent") indicates
5 on its face that it was issued on March 14, 2000. Abbyy USA is without information sufficient
6 to form a belief as to the truth of the allegations regarding ownership contained in paragraph 39,
7 and on that basis, denies the allegations. Abbyy USA denies that the '342 patent was properly
8 issued and that it is valid.

9 9. Abbyy USA admits that U.S. Patent No. 5,261,009 ("the '009 patent") indicates
10 on its face that it was issued on November 9, 1993. Abbyy USA is without information
11 sufficient to form a belief as to the truth of the allegations regarding ownership contained in
12 paragraph 40, and on that basis, denies the allegations. Abbyy USA denies that the '009 patent
13 was properly issued and that it is valid.

14 **NUANCE'S TRADE DRESS**

15 10. Abbyy USA denies the allegations contained in paragraph 41, alleging further in
16 that regard that Nuance has routinely changed its trade dress, so that no distinctive packaging or
17 otherwise has been established.

18 11. Abbyy USA denies the allegations contained in paragraph 42.

19 12. Abbyy USA denies the allegations contained in paragraph 43.

20 13. Abbyy USA denies the allegations contained in paragraph 44.

21 **COUNTERCLAIM ONE – INFRINGEMENT OF THE '053 PATENT**

22 14. Abbyy USA denies the allegations contained in paragraph 45.

23 15. Abbyy USA denies the allegations contained in paragraph 46.

24 16. Abbyy USA denies the allegations contained in paragraph 47.

25 **COUNTERCLAIM TWO – INFRINGEMENT OF THE '489 PATENT**

26 17. Abbyy USA denies the allegations contained in paragraph 48.

27 18. Abbyy USA denies the allegations contained in paragraph 49.

28 19. Abbyy USA denies the allegations contained in paragraph 50.

COUNTERCLAIM THREE – INFRINGEMENT OF THE ‘983 PATENT

20. Abbyy USA denies the allegations contained in paragraph 51

21. Abbyy USA denies the allegations contained in paragraph 52

22. Abbyy USA denies the allegations contained in paragraph 53.

COUNTERCLAIM FOUR – INFRINGEMENT OF THE ‘342 PATENT

23. Abbyy USA denies the allegations contained in paragraph 54.

24. Abbyy USA denies the allegations contained in paragraph 55.

25. Abbyy USA denies the allegations contained in paragraph 56.

COUNTERCLAIM FIVE – INFRINGEMENT OF THE ‘009 PATENT

26. Abbyy USA denies the allegations contained in paragraph 57.

27. Abbyy USA denies the allegations contained in paragraph 58.

28. Abbyy USA denies the allegations contained in paragraph 59.

COUNTERCLAIM SIX – INFRINGEMENT OF NUANCE’S TRADE DRESS IN

VIOLATION OF 15 U.S.C. § 1125(a)

29. Abbyy USA incorporates its responses in paragraphs 10 through 13, above.

30. Abbyy USA denies the allegations contained in paragraph 61.

31. Abbyy USA denies the allegations contained in paragraph 62.

32. Abbyy USA denies the allegations contained in paragraph 63.

33. Abbyy USA denies the allegations contained in paragraph 64.

34. Abbyy USA denies the allegations contained in paragraph 65.

35. Abbyy USA denies the allegations contained in paragraph 66.

36. Abbyy USA denies the allegations contained in paragraph 67.

37. Abbyy USA denies the allegations contained in paragraph 68.

COUNTERCLAIM SEVEN – COMMON LAW TRADE DRESS INFRINGEMENT

38. Abbyy USA incorporates its responses in paragraphs 29 through 37, above.

39. Abbyy USA denies the allegations contained in paragraph 70.

40. Abbyy USA denies the allegations contained in paragraph 71.

COUNTERCLAIM EIGHT – COMMON LAW UNFAIR COMPETITION

41. Abbyy USA incorporates its responses in paragraphs 29 through 40, above.

42. Abbyy USA denies the allegations contained in paragraph 73.

43. Abbyy USA denies the allegations contained in paragraph 74.

COUNTERCLAIM NINE – UNFAIR COMPETITION IN VIOLATION OF

CAL. BUS. & PROF. CODE § 17200 et seq.

44. Abbyy USA incorporates its responses in paragraphs 29 through 43, above.

45. Abbyy USA denies the allegations contained in paragraph 76.

46. Abbyy USA denies the allegations contained in paragraph 77.

47. Abbyy USA denies the allegations contained in paragraph 78.

COUNTERCLAIM TEN – FALSE AND DECEPTIVE ADVERTISING IN VIOLATION

OF CAL. BUS. & PROF. CODE § 17500, et seq.

48. Abbyy USA incorporates its responses in paragraphs 29 through 47, above.

49. Abbyy USA denies the allegations contained in paragraph 80.

50. Abbyy USA denies the allegations contained in paragraph 81.

ABBYY USA’S AFFIRMATIVE DEFENSES

Abbyy USA alleges the following defenses in response to the allegations in Nuance’s Counterclaim:

First Affirmative Defense

(Noninfringement)

51. Abbyy USA does not infringe, directly, contributorily, or by inducement, any valid or enforceable claim of the ‘053, ‘489, ‘983, ‘342, and ‘009 patents (collectively the “patents-in-suit”).

Second Affirmative Defense

(Prosecution History Estoppel)

52. To the extent Nuance attempts to assert infringement under the doctrine of equivalents, arguments and amendments contained in the prosecution history of the patents-in-

1 suit will estop or bar any claims for alleged infringement of the patents-in-suit.

2 **Third Affirmative Defense**

3 (Invalidity)

4 53. One or more of the claims of the patents-in-suit are invalid for failure to comply
5 with one or more of 35 U.S.C. §§ 101, 102, 103 and 112.

6 **Fourth Affirmative Defense**

7 (Laches/Prosecution Laches/Estoppel)

8 54. Any claims for alleged infringement of the patents-in-suit are barred or limited by
9 the doctrines of laches, waiver, prosecution laches and/or equitable estoppel.

10 **Fifth Affirmative Defense**

11 (Failure to Mark)

12 55. Any claims for damages for alleged infringement of the patents-in-suit are barred
13 or limited due to failure to allege compliance with (and failure to comply with) the requirements
14 of 35 U.S.C. § 287.

15 **Sixth Affirmative Defense**

16 (Adequate Remedy at Law)

17 56. Any claims for injunctive relief are barred in light of the fact that Nuance has an
18 adequate remedy at law.

19
20
21 Dated: July 30, 2008

FOLEY & LARDNER LLP
GRANT E. KINSEL

22
23
24 By: /s/ Grant E. Kinsel
GRANT E. KINSEL
25 Attorneys for Plaintiff
Abby USA Software House, Inc.
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JURY TRIAL DEMAND

Abby USA Software House, Inc., hereby demands a trial by jury.

Dated: July 30, 2008

FOLEY & LARDNER LLP
GRANT E. KINSEL

By: /s/ Grant E. Kinsel
GRANT E. KINSEL
Attorneys for Plaintiff
Abby USA Software House, Inc.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on July 30, 2008 I, electronically filed **ABBYY USA SOFTWARE HOUSE, INC.'S ANSWER TO COUNTERCLAIMS OF NUANCE COMMUNICATIONS, INC.** with the Clerk of Court by using the CM/ECF system which will send a notice of electronic filing to the following:

Seungtaik Michael Song
Wilson Sonsini Goodrich & Rosati
650 Page Mill
Palo Alto, CA 94303
6504939300
Email: msong@wsgr.com
ATTORNEY TO BE NOTICED

Attorneys for Defendant
Nuance Communications, Inc.

Tung-On Kong
Wilson Sonsini Goodrich & Rosati
Professional Corporation
650 Page Mill Road
Palo Alto, CA 94304-1050
650-493-9300
Fax: 650-565-5100
Email: tkong@wsgr.com
ATTORNEY TO BE NOTICED

/s/ Grant E. Kinsel
Grant E. Kinsel